

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 10/004,623

Filing Date: December 3, 2001

Title: GENERATION AND DISTRIBUTION OF PERSONALIZED MULTIMEDIA NATURAL PHENOMENOLOGICAL INFORMATION

Page 12

Dkt: 1081.001US2

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on June 20, 2002, and the documents cited therewith.

Claims 18, 19, 24, 25, 30, 35, 36, 41, 43-45, 47, 49, 51-53, 55 and 57-66 are amended, claims 54 and 67-69 are canceled, and no claims are added; as a result, claims 18-53 and 55-66 are now pending in this application.

18-53, 55-66

Double Patenting Rejection

Claims 18-69 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-39 of U.S. Patent No. 6,360,172. Applicant will consider filing a Terminal Disclaimer in compliance with 37 CFR 1.321(b)(iv) upon receiving an indication of allowable claims.

§112 Rejection of the Claims

Claims 18, 19, 24, 25, 30, 35, 36, 41, 43-45, 47, 49, 51-55 and 57-67 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Office Action stated that the use of the term "natural-phenomenological" has a dictionary meaning of "natural cognitive psychology". The Office Action further states that Applicant has defined the term to mean "metrological [sic] data." Applicant submits that the term has been defined in the specification more broadly than meteorological data. The term encompasses other types of natural events, including geological events, seismological events, hydrological events and cosmological events (see specification page 2, line 8 to page 3, line 2). Therefore, Applicant has amended the claims to replace occurrences of "natural-phenomenological" with "natural phenomena." The Merriam Webster online dictionary provides the following definition of "phenomena":

1. plural phenomena : an observable fact or event

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 10/004,623

Filing Date: December 3, 2001

Page 13

Dkt: 1081.001US2

Title: GENERATION AND DISTRIBUTION OF PERSONALIZED MULTIMEDIA NATURAL PHENOMENOLOGICAL INFORMATION

2. plural phenomena a : an object or aspect known through the senses rather than by thought or intuition b : a temporal or spatiotemporal object of sensory experience as distinguished from a noumenon c : a fact or event of scientific interest susceptible of scientific description and explanation
3. a : a rare or significant fact or event b plural phenomenons : an exceptional, unusual, or abnormal person, thing, or occurrence

The American Heritage Dictionary of the English Language, Fourth Edition Published by Houghton Mifflin Company includes the following definition of "phenomena":

4. Physics. An observable event.

Thus, natural phenomena as used in the amended claims is not repugnant to the usual meaning of the term. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 18, 19, 24, 25, 30, 35, 36, 41, 43-45, 47, 49, 51-55 and 57-67.

Claim 35 was also rejected under 35 USC § 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements. Applicant has amended claim 35 to clarify that the computer data is encoded onto a signal. Applicant respectfully requests the withdrawal of the rejection of claim 35.

Official Notice

In paragraph 7 of the Office Action, the Examiner takes official notice of a definition of the term "Personalized Natural-Phenomenological information" that appears to limit the scope of the term to meteorological events. Applicant respectfully traverses the official notice. As noted above, the specification also states that the term may include other events besides meteorological events, including hydrological, seismological, geological and cosmological events.

§102 Rejection of the Claims

Claims 18-52 and 55-66 were rejected under 35 USC § 102(b) as being anticipated by Zereski Jr. et al. (U.S. 5,654,886). Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough,

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 10/004,623

Filing Date: December 3, 2001

Title: GENERATION AND DISTRIBUTION OF PERSONALIZED MULTIMEDIA NATURAL PHENOMENOLOGICAL INFORMATION

Page 14

Dkt: 1081.001US2

however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Cornell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Applicant respectfully traverses the rejection because Zereski does not teach each and every element of Applicant’s claims.

An example of an element not taught by Zereski is found in independent claim 18, which recites “receiving predetermined criteria for selecting natural phenomena data, wherein the predetermined criteria comprises information that describes personal preference data of a subscriber.” Independent claims 24, 30 and 35 recite similar language. The Office Action cites column 2, lines 41-44 as teaching the recited language. Applicant respectfully disagrees with this interpretation of Zereski. Zereski, at column 7, line 54 to column 8 line 14 provides further details on the selection process of Zereski. The user must continuously perform selections of menu items and icons to reach an item of interest. For example, the user first may select a country such as the United States. The user then selects a city. In addition, the user must make further selections in order to obtain more details. This is quite different from Applicant’s claimed invention, in which the selection criteria are predetermined. As a result, Zereski does not teach or suggest predetermined selection criteria. Applicant respectfully requests the withdrawal of the rejection of claims 18, 24, 30 and 35.

Claims 21-23, 25-29, 31-34 and 36-40 depend either directly or indirectly from claims 18, 24 30 and 35 respectively. Each of the dependent claims inherit the elements of their respective base claims and introduce further patentable distinctions. They are therefore allowable for the same reasons as discussed above with respect to their base claims. Applicant respectfully requests the withdrawal of the rejection of claims 21-23, 25-29, 31-34 and 36-40.

Independent claim 41, as amended, recites “a first field comprising data representing a subscriber data structure describing a receiver of natural phenomena data.” The Office Action states that in Zereski, a subscriber is a meteorologist. A meteorologist is a provider, not a receiver, of natural phenomena data. As a result, Zereski does not anticipate Applicant’s claims

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 10/004,623

Filing Date: December 3, 2001

Page 15

Dkt: 1081.001US2

Title: GENERATION AND DISTRIBUTION OF PERSONALIZED MULTIMEDIA NATURAL PHENOMENOLOGICAL INFORMATION

as amended. Applicant respectfully requests the withdrawal of the rejection of claim 41. Claims 42 and 43 depend from claim 41, and are therefore allowable for the same reasons as discussed above.

Independent claim 44 recites "a natural phenomena-preference data structure containing data representing at least one natural phenomena-preference for the particular person identified by the person type field." The Office Action states that Zerenski's meteorological forecast 14 is a preference data structure. Applicant respectfully disagrees with this interpretation of Zerenski. A forecast is a prediction of a future meteorological condition. It does not indicate a user preference. While Zerenski allows such a forecast to be selected, there is no indication that this selection is stored as a data structure. As a result, Zerenski does not teach or disclose a natural phenomena-preference data structure. Applicant respectfully requests the withdrawal of the rejection of claim 44. Claims 45-47 depend either directly or indirectly from claim 44, and are therefore allowable for the same reasons as discussed above.

Independent claim 48 recites "a preference type field containing data representing an identifier of a particular preference." The Office Action states that Zerenski's requestor 40 discloses a preference type field. Requestor 40 merely provides to an asset database. The requestor 40 supplies various translators (60, 64, 68) for various types of source data. This source data is assembled in anticipation of future requests regardless of whether a user selected it or not. As a result, there is no preference involved and requestor 40 cannot be a preference field type. Applicant respectfully requests the withdrawal of the rejection of claim 48.

Claim 48 also recites "a sensitivity data structure containing data representing a sensitivity for the particular preference identified by the preference type field." The Office Action states that asset assembler 42 discloses such a sensitivity data structure. Applicant can find no mention of sensitivity in Zerenski. Applicant respectfully requests that the Examiner withdraw the rejection of claim 48 or alternatively provide a citation to a column and line where such a sensitivity data structure is disclosed.

Claims 49-50 depend directly or indirectly from claim 48 and are allowable for at least the same reasons as discussed above.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 10/004,623

Filing Date: December 3, 2001

Title: GENERATION AND DISTRIBUTION OF PERSONALIZED MULTIMEDIA NATURAL PHENOMENOLOGICAL INFORMATION

Page 16

Dkt: 1081.001US2

Claim 51 recites "generating a personalized natural phenomena forecast." Similarly, claim 55 recites "generating a personalized natural phenomena text string. Claims 59 and 63 also recite language related to personalization. As discussed above, Zerenski responds to user menu and icon selections to provide previously assembled data at the time of the selection. There is no teaching or suggestion in Zerenski that the data is personalized for any particular user. As a result, Zerenski does not personalize the data presented to a user. Applicant respectfully requests the withdrawal of the rejection of claims 51, 55, 59 and 63.

Claim 52 depends from claim 51, claims 56-58, 60-62 and 64-66 depend directly or indirectly from claims 55, 59 and 63 respectively. These dependent claims are therefore allowable for the same reasons as their respective base claims.

Claims 67-69 were also rejected under 35 USC § 102(b) as being anticipated by Dey (The WMO Format For The Storage Of Weather Product Information And The Exchange Of Weather Product Messages In Gridded Binary Form As Used By NCEP Central Operations, Edition I, Office Note 388--GRIB, National Centers for Environmental Prediction Central Operations, 105 p., (March 10, 1998)). In order to expedite prosecution, Applicant has canceled claims 67-69. Applicant reserves the right to introduce these claims in a continuing application.

§103 Rejection of the Claims

Claims 53 and 54 were rejected under 35 USC § 103(a) as being unpatentable over Zereski Jr. et al. in view of Office Note 388--GRIB by the NWS. In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Applicant

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 10/004,623

Filing Date: December 3, 2001

Page 17

Dkt: 1081.001US2

Title: GENERATION AND DISTRIBUTION OF PERSONALIZED MULTIMEDIA NATURAL PHENOMENOLOGICAL INFORMATION

respectfully traverses the rejection, because the claims contain elements not taught or suggested by Zereski Jr. et al. in view of Office Note 388--GRIB by the NWS.

Claim 54 has been canceled without prejudice in this response. Amended claim 53 recites in part "generating a text string of personalized natural phenomena from the gridded database object." As discussed above, Zereski does not teach or disclose personalization of any kind. Further Office Note 388 also does not teach or disclose personalization of any kind. As a result, neither reference, alone or in combination, teaches each and every limitation of claim 53. Applicant respectfully requests the withdrawal of the rejection of claim 53.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-371-2169) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

CRAIG R. BURFEIND ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6954

Date December 20, 2002 By [Signature]
Rodney L. Lacy
Reg. No. 41,136

I hereby certify that this paper is being transmitted by facsimile to the U.S. Patent and Trademark Office on the date shown below.

[Signature]
Rodney L. Lacy

December 20, 2002
Date of Transmission

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 10/004,623

Filing Date: December 3, 2001

Page 18

Dkt: 1081.001US2

Title: GENERATION AND DISTRIBUTION OF PERSONALIZED MULTIMEDIA NATURAL PHENOMENOLOGICAL INFORMATION